

ESTTA Tracking number: **ESTTA237339**

Filing date: **09/17/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91185700
Party	Defendant Omni United (S) Pte Ltd
Correspondence Address	THOMAS W. COOK THOMAS COOK INTELLECTUAL PROPERTY P. O. BOX 1989 SAUSALITO, CA 94965 UNITED STATES
Submission	Answer
Filer's Name	Thomas W. Cook
Filer's e-mail	khorne@thomascooklaw.com
Signature	/Thomas W. Cook/
Date	09/17/2008
Attachments	2008 09 17 Answer to Notice of Opposition.pdf ( 5 pages )(171816 bytes )

1                   **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
2                   **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3   In the Matter of Trademark Application Serial No. 77308830

4   Mark:           LEOI

5  
6   Zhaoyuan Leo Rubber Co., Ltd. and  
7   Shandong Linglong Rubber Co., Ltd

8                   Opposers,

9                   v.

10   Omni United (S) Pte, Ltd.,

11                   Applicant.

Opposition No. 91185700

APPLICANT'S ANSWER

12  
13                   **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION**

14           Applicant herein, Omni United (S) Pte, Ltd., by its attorney, responds as follows to the  
15   Notice of Opposition dated August 6, 2008, filed by Opposers, Zhaoyuan Leo Rubber Co. Ltd.,  
16   and Shandong Linglong Rubber Co., Ltd.

17           With respect to the initial paragraph of the Notice of Opposition, Applicant is without  
18   knowledge or information sufficient to form a belief as to the truth of the allegations set forth in  
19   the initial paragraph of the Notice of Opposition and, therefore, Applicant on that basis denies  
20   each and every allegation contained therein, leaving Opposers to their proof thereof.

21           Furthermore, Applicant denies any and all other allegations in the Notice of Opposition  
22   not specifically admitted herein.

23           In further Answer to the Notice of Opposition, Applicants aver as follows (per numbered  
24   paragraph of the Notice of Opposition):

25           1.       Responding to the allegations set forth in Paragraph 1, Applicant denies Opposer  
26   Linglong is the owner of the mark LEAO, or the stylized form of the mark LEAO which,  
27   according to Opposers, "has the appearance similar to the word LEOI", in connection with tires  
28   in the United States. Applicant denies Opposer's own "the word LEOI," and Applicant denies

1 the mark LEAO "has the appearance similar to the word LEOI," as asserted by Opposer.

2         2.       Responding to the allegations set forth in Paragraph 2, Applicant is without  
3 knowledge or information sufficient to form a belief as to the truth of the allegations set forth in  
4 Paragraph 2, in that Applicant is without knowledge of Opposers, their business structure,  
5 personnel, licenses, trademarks, goods, or activities, and on that basis Applicant denies each and  
6 every allegation contained in Paragraph 2.

7         3.       Responding to the allegations set forth in Paragraph 3, Applicant is without  
8 knowledge or information sufficient to form a belief as to the truth of the allegations set forth in  
9 Paragraph 3, in that Applicant is without knowledge of Opposers, their business structure,  
10 personnel, licenses, trademarks, goods, or activities, and on that basis Applicant denies each and  
11 every allegation contained in Paragraph 3.

12         4.       Responding to the allegations set forth in Paragraph 4, Applicant denies Opposer  
13 Shandong is the owner of the trademarks LEAO and LEOI in the United States. Applicant is  
14 without knowledge or information sufficient to form a belief as to the truth of the remaining  
15 allegations set forth in Paragraph 4, in that Applicant is without knowledge of Opposers, their  
16 business structure, personnel, licenses, trademarks, goods, or activities, and on that basis  
17 Applicant denies each and every allegation contained in Paragraph 4.

18         5.       Responding to the allegations set forth in Paragraph 5, Applicant admits the  
19 allegations contained therein.

20         6.       Responding to the allegations set forth in Paragraph 6, Applicant admits the  
21 mark shown in Applicant's application (i.e., LEOI) is highly similar to the word LEOI Opposers  
22 assert is similar to the mark LEAO which Opposers assert Shandong owns; LEOI is in fact  
23 identical to LEOI. Applicant admits Applicant's identified goods are closely related to Opposers'  
24 Goods.

25         7.       Responding to the allegations set forth in Paragraph 7, Applicant does not know  
26 what "the goods" means. Applicant therefore denies each and every allegation in Paragraph 7.

27         8.       Responding to the allegations set forth in Paragraph 8, Applicant denies each and  
28 every allegation in Paragraph 8.

1           9.       Responding to the allegations set forth in Paragraph 9, Applicant admits the  
2 agreement between these parties contains the language “to jointly establish the market for second  
3 party’s proprietary brand ‘LEAO’ in the markets agreed on jointly.” Applicant denies this  
4 language in the referenced agreement affects Applicant’s rights to its trademarks in the United  
5 States.

6           10.      Responding to the allegations set forth in Paragraph 10, Applicant admits the  
7 agreement between these parties contains the language “First party agrees to: a. Representing  
8 second party’s proprietary brand ‘LEAO’ exclusively for” North America (USA, Canada,  
9 Mexico). Applicant denies this language in the referenced agreement affects Applicant’s rights to  
10 its trademarks in the United States.

11          11.      Responding to the allegations set forth in Paragraph 11, Applicant denies each and  
12 every allegation contained in Paragraph 11.

13          12.      Responding to the allegations set forth in Paragraph 12, Applicant admits it  
14 distributed in the United States tires manufactured by Shandong in China. Applicant denies such  
15 distribution gives Opposers rights in or to Applicant’s mark.

16          13.      Responding to the allegations set forth in Paragraph 13, Applicant is without  
17 knowledge or information sufficient to form a belief as to the truth of the remaining allegations  
18 set forth in Paragraph 13, in that Applicant is without knowledge of Opposers, their business  
19 structure, personnel, licenses, trademarks, goods, or activities, and on that basis Applicant denies  
20 each and every allegation contained in Paragraph 13.

21          14.      Responding to the allegations set forth in Paragraph 14, Applicant admits it  
22 distributed in the United States tires manufactured by Shandong in China. Applicant denies such  
23 distribution gives Opposers rights in or to Applicant’s mark.

24          15.      Responding to the allegations set forth in Paragraph 15, Applicant is without  
25 knowledge or information sufficient to form a belief as to the truth of the remaining allegations  
26 set forth in Paragraph 15, in that Applicant is without knowledge of Opposers, their business  
27 structure, personnel, licenses, trademarks, goods, or activities, and on that basis Applicant denies  
28 each and every allegation contained in Paragraph 15.

1           16.     Responding to the allegations set forth in Paragraph 16, Applicant admits it stated  
2 its belief that it was the owner of the mark shown in the application referred to by Opposers, and  
3 to the best of Applicant's knowledge and belief no other person had the right to use the mark in  
4 commerce. Applicant denies the remainder of the allegations in Paragraph 16.

5           17.     Responding to the allegations set forth in Paragraph 17, Applicant admits the  
6 examining attorney allowed Applicant's application for publication relying on the truth of  
7 Applicant's statements. Applicant denies the remainder of the allegations contained in Paragraph  
8 17.

9           18.     Responding to the allegations set forth in Paragraph 18, Applicant denies each and  
10 every allegation contained in Paragraph 18.

11           19.     Responding to the allegations set forth in Paragraph 19, Applicant denies each and  
12 every allegation contained in Paragraph 19.

#### 13 14                   **AFFIRMATIVE AND SPECIAL DEFENSES**

15           Applicants hereby incorporate by reference numbered Paragraphs 1 through 19, inclusive,  
16 and the initial paragraph of this Answer.

17           1.     On information and belief, Opposers have not used the mark, and/or have not  
18 continuously used the alleged mark, and so Opposers have failed to establish and maintain a  
19 viable trademark right in the alleged mark.

20           2.     On information and belief, Opposers knew or should have known of Applicant's  
21 use of Applicants' mark prior to Opposers' filing of its Notice of Opposition, but waited an  
22 unreasonable period of time before filing such Notice. Opposers have therefore lost the right to  
23 now assert that they will be damaged by the registration of Applicants' mark under doctrines of  
24 acquiescence, estoppel, and laches.

25           3.     Opposers' Notice of Opposition fails to state a claim upon which relief may be  
26 granted.

27           WHEREFORE, Applicant respectfully prays that:


28           1.     Opposers' Notice of Opposition be dismissed in its entirety, with prejudice, and

1 that Application Serial No. 77308830 be allowed to proceed to registration, and

2 2. Applicant be granted such further and additional relief as the Trademark Trial  
3 and Appeal Board deems proper and just.

4 Respectfully submitted,

5  
6  
7 Date: September 17, 2008

  
Thomas W. Cook, Reg. No. 38,849  
Attorney for Applicant  
3030 Bridgeway, Suite 425-430  
Sausalito, California 94965  
Telephone: 415-339-8550

11  
12 **CERTIFICATE OF SERVICE BY U.S. MAIL, 37 C.F.R. §2.119(a)**

13 I, hereby declare:

14 I am over the age of 18 years, and am not a party to the within cause. I am employed in  
15 Sausalito, California.

16 My business address is 3030 Bridgeway, Suite 425-430, Sausalito, California. My mailing  
17 address is P.O. Box 1989, Sausalito, California.

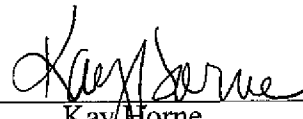
18 On the date first written below, I served a true copy of the attached document entitled:

19 **APPLICANTS' ANSWER**

20 by placing it in a sealed envelope and depositing it in the United States mail, first class postage  
21 fully prepaid, addressed to the following:

22 Marie-Anne Mastrovito  
23 Abelman, Frayne & Schwab  
24 666 Third Avenue  
New York, NY 10017

25 I declare under penalty of perjury that the foregoing is true and correct. Executed at  
26 Sausalito, California on September 17, 2008.

27  
28   
Kay Horne